

REMARKS

Claims 1 and 8-12 are pending in this application. By this Amendment, claims 1 and 10 are amended, claims 11 and 12 are newly added, and claims 2-7 are canceled. Support for the amendments to the claims can be found, for example, in the original claims and in the specification at the Examples and pages 10-13. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

I. Obviousness-Type Double Patenting

The Office Action provisionally rejects claims 1-10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of co-pending U.S. Patent Application No. 11/727,111. By this Amendment, claims 2-7 are canceled, thus the rejection is moot as to those claims. As to the remaining claims, without admitting to the propriety of the rejection, and in the interest of advancing prosecution, Applicants are simultaneously filing herewith a Terminal Disclaimer over the cited reference, thus obviating the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejections Under 35 U.S.C. §102/§103

A. JP '941 or JP '930

The Office Action rejects claims 1-6, 9 and 10 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over either JP 09-282941 ("JP '941") or JP 2000-076930 ("JP '930"). By this Amendment, claims 2-6 are canceled, thus the rejection is moot as to those claims. As to the remaining claims, Applicants respectfully traverse the rejection.

Without conceding to the propriety of the rejection, and in the interest of furthering prosecution, the subject matter of non-rejected claim 7 is incorporated into amended claim 1. Thus, neither JP '941 nor JP '930 teach or suggest each and every feature of amended claim 1.

JP '941 and JP '930 do not anticipate, and would not have rendered obvious claim 1. Claims 9 and 10 variously depend from claim 1 and, thus, also are not anticipated by and would not have been rendered obvious by JP '941 and JP '930. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Mukuno or Hayashi

The Office Action rejects claims 1-6, 9 and 10 under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,494,931 to Mukuno et al. ("Mukuno") or under U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent Application Publication No. 2001/0018116 to Hayashi et al. ("Hayashi"). By this Amendment, claims 2-6 are canceled, thus the rejection is moot as to those claims. As to the remaining claims, Applicants respectfully traverse the rejection.

Without conceding to the propriety of the rejection, and in the interest of furthering prosecution, the subject matter of non-rejected claim 7 is incorporated into amended claim 1. Thus, neither Mukuno nor Hayashi teach or suggest each and every feature of amended claim 1.

Mukuno and Hayashi do not anticipate, and would not have rendered obvious claim 1. Claims 9 and 10 variously depend from claim 1 and, thus, also are not anticipated by and would not have been rendered obvious by Mukuno and Hayashi. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejections Under 35 U.S.C. §103

A. JP '941 or JP '930

The Office Action rejects claims 7 and 8 under 35 U.S.C. §103(a) over JP '941 or JP '930. By this Amendment, claim 7 is canceled, thus the rejection is moot as to that claim. As this rejection applies to amended claim 1 and the remaining claims, Applicants respectfully traverse the rejection.

By this Amendment, claim 1 is amended to recite, "...said electrode material powder comprises from 40 to 50 parts by weight of the entire internal electrode paste; a polymerization degree of said polyvinyl butyral resin and/or polyvinyl acetal resin is from 1400 to 3600; said binder resin comprises from 2.5 to 5.5 parts by weight with respect to 100 parts by weight of said electrode material powder and ceramic powder; and said plasticizer comprises between 25 to 150 parts by weight with respect to 100 parts by weight of said binder resin." JP '941 or JP '930 fail to teach or suggest such features.

The Office Action, on page 6, recognizes that JP '941 and JP '930 fail to disclose the claimed polymerization/acetylation amount. However, the Office Action asserts that the optimization of such variables is well known in the art. Additionally, the Office Action, on page 5 asserts that the specific features of amended claim 1 are either disclosed or inherent in JP '941 and JP '930. Applicants respectfully assert that the combinations recited in amended claim 1 are not inherent and would not have been rendered obvious by the disclosures of JP '941 and JP '930.

JP '941 merely discloses a conductive paste consisting of metal particles, an organic binder, and an organic solvent. However, JP '941 does not disclose a plasticizer or a ceramic powder, nor does it disclose the precise amounts of the components that comprise the internal electrode paste as recited in amended claim 1, such as the electrode material powder should be from 40 to 50 parts by weight of the entire internal electrode paste. Moreover, JP '941

teaches, in detail, that controlling the size and size distribution of the metal particles used in the conductive paste improves the performance of the paste. See JP '941, computer translation, paragraphs [0008]-[0010]. However, JP '941 fails to disclose that adjusting the amounts of the components that comprise the conductive paste will improve the performance of the paste, except in paragraph [0014] where the reference discloses that the "binder into 1-5 weight section to the metal-particles 100 weight section" in order to improve the "presswork" of the conductive paste. Therefore, one of ordinary skill in the art would only have been motivated to adjust the metal particle size and particle size distribution to improve the performance of the electrode paste disclosed by JP '941. However, JP '941 fails to disclose a reason or rationale for one of ordinary skill in the art to have combined the features as claimed to improve the performance of the conductive paste disclosed in JP '941.

Further, JP '930 does not teach or suggest, inherently or otherwise, the specific combination of components in an internal electrode paste as recited in amended claim 1. JP '930 discloses that the amount of the metal powder should be "to the binder resin 100 weight section the 500-2000 weight section and that it is the 700-1300 weight section preferably." JP '930, computer translation, paragraph [0022]. This portion of the JP '930 reference indicates that the amount of the binder to the metal powder should be in a range from 0.05 (100 parts by weight binder resin to 2000 parts by weight metal powder) to 0.2 (100 parts by weight binder resin to 500 parts by weight metal powder) parts by weight to the metal powder. This disclosed range is drastically different than the 2.5 to 5.5 parts by weight binder resin to electrode material powder and ceramic material powder as recited in claim 1.

Furthermore, JP '930 teaches that the viscosity of the electrode paste should be within a predetermined range in order to improve the performance of imprinting the electrode paste to a substrate, and the viscosity is primarily controlled by a solvent. See JP '930, computer translation, paragraph [0031]. Therefore, JP '930 does not provide a reason or rationale for

one of ordinary skill in the art to have modified the electrode paste disclosed by JP '930 to yield the internal electrode paste as recited in amended claim 1.

For at least the reasons stated above, claim 1 would not have been rendered obvious by JP '941 or JP '930. Claim 8 depends from claim 1 and, thus, also would not have been rendered obvious by JP '941 or JP '930. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Mukuno and Hayashi

The Office Action rejects claims 7 and 8 under 35 U.S.C. §103(a) over Mukuno or Hayashi. By this Amendment, claim 7 is canceled, thus the rejection is moot as to that claim. As this rejection applies to amended claim 1 and the remaining claims, Applicants respectfully traverse the rejection.

For reasons similar to those outlined above, Mukuno and Hayashi fail to teach or suggest each and every feature of amended claim 1. Namely, neither Mukuno nor Hayashi teach or suggest the precise combination and amounts of the components recited in amended claim 1. Neither of these applied references discloses, for example, the amount of the electrode material powder or the amount of the binder resin as compared to 100 parts by weight of the electrode material powder and the ceramic powder of the claimed internal electrode paste.

Further, both Mukuno and Hayashi teach that uniform metal particle size within a predetermined range increases the performance of the conductive paste. Therefore, similar to the argument made against JP '941 above, neither Mukuno nor Hayashi provide a reason or rationale for one of ordinary skill in the art to have modified the conductive pastes disclosed by Mukuno or Hayashi to yield the precise amounts and components of the internal electrode paste as recited in amended claim 1.

For at least the reasons stated above, claim 1 would not have been rendered obvious by Mukuno or Hayashi. Claim 8 depends from claim 1 and, thus, also would not have been rendered obvious by Mukuno or Hayashi. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. New Claims

By this Amendment, new claims 11 and 12 are presented. New claims 11 and 12 depend from claim 8, which depends from claim 1, and, thus, distinguish over the applied references for at least the reasons discussed above with respect to claim 1, as well as for the additional features that they recite. Prompt examination and allowance of new claims 11 and 12 are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Nicolas A. Brentlinger
Registration No. 62,211

JAO:NAB/kjl

Attachment:
Terminal Disclaimer

Date: October 3, 2008

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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